

REMARKS

This response supplements the earlier filed RCE which used the After Final Response filed on August 16, 2004. The earlier After Final Response with amendments concentrated on advancing prosecution and is incorporated herein by reference. This Supplemental Response now addresses other issues raised in the Examiner's Made Final Office Action of June 15, 2004 so as to be fully responsive.

The independent claims have been amended to recite a gaming machine receiving a wager, a casino bonus game, and bonus awards as suggested by the Made Final Office Action ("OA") at page 9, lines 1-6 and to provide proper antecedents.

Supplemental Response

Claims 36, 39-43, 46-47 and 49-58 were rejected under 35 U.S.C. 103(a) based on Cork and Muzaffar ("Muza"). Claims 37-38, 44-45 and 48 are now canceled.

While it is maintained that the prior After Final amendments to claims 36, 41, 52 and 55 fully distinguish the inventions over Cork and Muza, alone or together, the following addresses other issues raised in the Made Final Office Action ("OA").

Cork does not disclose "a strategy-based casino bonus game" as stated at page 3, second paragraph of the OA. A Cork player cannot use strategy (let alone, optimal strategy) in play to minimize player inputs to obtain a larger award. In Cork, a player places Xs (see Figure 4 and page 6, lines 1-17) and then the Cork microprocessor randomly places the ball on the screen (page 6, lines 24-26). The player in Cork wins only by random luck. The player of the claimed invention has a "given number of player inputs" (independent claims 36, 41, 52 and 55). This is not shown in the "number of regions of screen to be selected" of Cork (page 8, paragraph 1). Regions to be selected are not player inputs that are received from the player as claimed and taught in the specification. Cork teaches that the player places all of a predetermined number of Xs (see Figure 4) on the screen at the same time. This "predetermined number of X's" does not vary as claimed where the given number of inputs of claims 36 and 41 have the lowest award and the highest award for the "minimum number of received inputs." Claims 52 and 55 end the game when the given number has been inputted without a solution. The expansion of Cork's target area does not provide this teaching. The player in Cork always first makes the predetermined number of Xs, then the game selectively

expands the target until an X hits the target, the expansion reduces the award. This bears no resemblance to the claimed invention. All claims are patentably distinct.

In response to the bridging paragraph of pages 3-4 of the OA, Muza requires (1) a video sequence to be first shown to the player having a game ball. Muza then (2) retrieves a static frame from the video sequence, (3) removes the ball from the static frame, and (4) requires the player to "guess" where the ball is based on "memory." A (5) prize is awarded if the player is correct. Muza's five step process does not suggest, infer or render obvious the invention in the pending claims. This is not "strategy based" as stated in the Office Action, but is "memory based." There is no strategy (e.g., TIC-TAC-TOE has strategy) in the memory-based game of Muza. Furthermore, Muza's expansion to "levels" on page 4 does not embrace "strategy." Muza suggests "... several selections on one or several screens" which means the player can re-guess to test memory on the same static frame, or other static screens. This is entirely different from the claimed invention that is based on an optimal minimal number of strategy inputs from a player resulting in the greatest award. The Office Action states "Also note that Moza [sic] explicitly states that which is implicit in Cork and applies to "spot-the-ball" type games in that they are strategy based or skill based games rather than chance games." It is respectfully maintained that this statement is incorrect. First, Cork is "random luck" based, the player in Cork isn't given a video showing where the ball is, before selecting. Cork is only a "chance" game with no memory aids, no skills by the player, or no strategy of the player. Muza is not a chance game as the player is first shown where the ball is at. Muza is only a memory game, not a chance game, no skills (other than memory) with no strategy by the player.

In response to the first full paragraph on page 4 of the OA, the use of the term "compound hidden pattern" is fully set forth in the specification. Cork randomly hides a ball. Cork places all of the Xs, (Figure 4), the game reveals the hidden ball. When one X hits the revealed ball, the player wins. Claims 36 and 41 recites "after each received input, displaying whether a part of the compound hidden pattern is uncovered" and "based on the aforesaid part of the compound hidden pattern displayed ... using strategy by the player to provide the next player input." This is not taught by Cork. Cork either has a hit or not. The Cork player inputs all Xs first and never places another input after the hidden ball is displayed!

Each independent claim is limited to strategy with the player being (1) given a number of inputs and then (2) receiving the greatest award with (3) minimal inputs as a result of optimum strategy. Neither Cork or Muza teach, suggests or infer these three recited claim features.

The OA recognizes that Cork requires the player to place all Xs first and relies on Muza for teaching an input, reveal, an input, reveal, etc. As stated above, Muza teaches a memory-based process not a strategy-based game as claimed. More importantly, it is respectfully maintained that no suggestion, motivation or teaching is found in either reference to combine with the other as stated. Or, that knowledge available to one skilled in the art would make such a combination, with no knowledge of the claimed invention. In re Bruce Beasley, __ USPQ 2d ____ (CAFC, December 7, 2004) requires more than conclusionary statements such as of "attractive, interesting and challenging." Cork only teaches the player first "placing all Xs," there is no motivation to do otherwise. Indeed, Cork only changes the target area by expanding the radius of the ball. Muza only reproduces the hidden image of a ball. The only motivation would be to allow a Cork player, after seeing the Muza video, to play a number of Xs based on his/her memory either all at once or interactively. Even so, this is not strategy.

The Trend reference does not provide any of the claimed inventive features found in each independent claim. It is maintained that the case is in condition for allowance and such allowance is respectfully requested.

Should you have any questions regarding the above, please feel free to give the below-listed attorney a call. If additional fees are required, please debit our Deposit Account No. 04-1414.

Respectfully submitted,

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2/1/05

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PATENT APPLICATION FEE DETERMINATION RECORD						Application or Docket Number 1482/187(d)							
CLAIMS AS FILED – PART I						SMALL ENTITY		OR		OTHER THAN SMALL ENTITY			
(Column 1)		(Column 2)		(Column 3)		RATE		FEE		RATE		FEE	
FOR		NUMBER FILED		NUMBER EXTRA		RATE		FEE		RATE		FEE	
BASIC FEE (37 CFR 1.16(a))								\$				\$ 740	
TOTAL CLAIMS (37 CFR 1.16(c))		23 minus 20 =		3		X \$				X \$ 18 =		54	
INDEPENDENT CLAIMS (37 CFR 1.16(b))		4 minus 3 =		1		X \$				X \$ 84 =		84	
MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(d))						+ \$				+ \$			
* If the difference in column 1 is less than zero, enter "0" in column 2.						TOTAL				OR TOTAL		878	
CLAIMS AS AMENDED – PART II						SMALL ENTITY		OR		OTHER THAN SMALL ENTITY			
(Column 1)		(Column 2)		(Column 3)		RATE		ADDITIONAL FEE		RATE		ADDITIONAL FEE	
CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR		PRESENT EXTRA		RATE		ADDITIONAL FEE		RATE		ADDITIONAL FEE	
Total (37 CFR 1.16(c))		23 Minus		23 =		X \$				X \$ 18 =		0	
Independent (37 CFR 1.16(b))		4 Minus		4 =		X \$				X \$ 86 =		0	
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(d))						+ \$				+ \$			
TOTAL ADD'L FEE								OR TOTAL ADD'L FEE		0			
(Column 1)		(Column 2)		(Column 3)		RATE		ADDITIONAL FEE		RATE		ADDITIONAL FEE	
CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR		PRESENT EXTRA		RATE		ADDITIONAL FEE		RATE		ADDITIONAL FEE	
Total (37 CFR 1.16(c))		22 Minus		23 =		X \$				X \$ 18 =		0	
Independent (37 CFR 1.16(b))		4 Minus		4 =		X \$				X \$ 86 =		0	
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(d))						+ \$				+ \$			
TOTAL ADD'L FEE								OR TOTAL ADD'L FEE		0			
(Column 1)		(Column 2)		(Column 3)		RATE		ADDITIONAL FEE		RATE		ADDITIONAL FEE	
CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR		PRESENT EXTRA		RATE		ADDITIONAL FEE		RATE		ADDITIONAL FEE	
Total (37 CFR 1.16(c))		18 Minus		23 =		X \$				X \$ 50 =		0	
Independent (37 CFR 1.16(b))		4 Minus		4 =		X \$				X \$ 200 =		0	
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(d))						+ \$				+ \$			
TOTAL ADD'L FEE								OR TOTAL ADD'L FEE		0			

* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.
 ** If the "Highest Number Previously Paid For" in THIS SPACE is less than 20, enter "20".
 *** If the "Highest Number Previously Paid For" in THIS SPACE is less than 3, enter "3".
 The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.

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